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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,110	06/16/2000	Kazumoto Kondo	450100-02572	2719
20999	7590	03/16/2005	EXAMINER	
FROMMERM LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			SMITH, PETER J	
		ART UNIT		PAPER NUMBER
		2176		

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/596,110	KONDO, KAZUMOTO	
	<b>Examiner</b>	<b>Art Unit</b>	
	Peter J Smith	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 January 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-6 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. This action is responsive to communications: amendment filed 11/3/2004, RCE filed on 1/3/2005.
2. Claims 1-6 are pending in the case. Claims 1 and 4 are independent claims.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 3-4, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman et al. (hereinafter “Huffman”), US 5,663,748 issued 09/02/1997 in view of Huang, US 6,384,815 B1 filed 2/24/1999.**

**Regarding independent claim 1,** Huffman teaches a display means for displaying multiple elements forming contents of book in fig. 1-7, and col. 3 line 64 – col. 4 line 3. Huffman teaches a display control means for determining, based upon a selection technique for specifying one of said multiple elements, a type of mark to emphasize a specified element, said selection technique being defined according to a position specified by an area of the display touched by a user displaying the specified element when an optional element is specified from among said multiple elements via input means and for attaching said determined mark to said specified element in fig. 19, 23, 27, and col. 17 line 62 – col. 18 line 24. The selection of elements to be marked is shown in fig. 19. The selection technique is defined according to a

position specified by an area of the display touched by a user displaying the specified element in fig. 20.

Huffman requires a two step process to implement the highlighting of text by first selecting the range of text to be highlighted followed by the user selecting the highlighting action. Therefore, Huffman does not teach selecting the range and marking text in a single-step action. Huang does teach an improved electronic text highlighting technique which selects and marks the text in a single step in col. 2 lines 30-60. Huffman teaches motivation for automatic single-step electronic text highlighting in col. 2 lines 10-19 to eliminate the need for a user to explicitly selecting either a writing pen function or a highlighter marker function. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Huffman and Huang to have created the claimed invention. It would have been obvious and desirable to have improved the highlighting function as taught in Huffman with the single-step highlighting function as taught by Huang so that the highlighting function would have been improved for the motivations set for by Huang in col. 2 lines 10-19.

**Regarding dependent claim 3,** Huffman teaches changing the display condition of a mark displayed on a specified element according to the specified operational procedure via an input means in fig. 19, 23, 27 and col. 17 line 62 – col. 18 line 24.

**Regarding independent claim 4,** Huffman teaches a display means for displaying multiple elements forming contents of book in fig. 1-7, and col. 3 line 64 – col. 4 line 3. Huffman teaches a display control means for determining, based upon a selection technique for specifying one of said multiple elements, a type of mark to emphasize a specified element, said selection technique being defined according to a position specified by an area of the display

touched by a user displaying the specified element when an optional element is specified from among said multiple elements via input means and for attaching said determined mark to said specified element in fig. 19, 23, 27, and col. 17 line 62 – col. 18 line 24. The selection of elements to be marked is shown in fig. 19. The selection technique is defined according to a position specified by an area of the display touched by a user displaying the specified element in fig. 20.

Huffman requires a two step process to implement the highlighting of text by first selecting the range of text to be highlighted followed by the user selecting the highlighting action. Therefore, Huffman does not teach selecting the range and marking text in a single-step action. Huang does teach an improved electronic text highlighting technique which selects and marks the text in a single step in col. 2 lines 30-60. Huffman teaches motivation for automatic single-step electronic text highlighting in col. 2 lines 10-19 to eliminate the need for a user to explicitly selecting either a writing pen function or a highlighter marker function. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Huffman and Huang to have created the claimed invention. It would have been obvious and desirable to have improved the highlighting function as taught in Huffman with the single-step highlighting function as taught by Huang so that the highlighting function would have been improved for the motivations set for by Huang in col. 2 lines 10-19.

**Regarding dependent claim 6,** Huffman teaches changing the display condition of a mark displayed on a specified element according to the specified operation procedure via an input means in fig. 19, 23, 27 and col. 17 line 62 – col. 18 line 24.

**5. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman et al. (hereinafter “Huffman”), US 5,663,748 issued 09/02/1997 in view of Huang, US 6,384,815 B1 filed 2/24/1999 as applied to claims 1 and 4 above, and further in view of Hastings et al. (hereinafter “Hastings”), US 5,885,012 filed 6/2/1997.**

**Regarding dependent claim 2,** Huffman does not teach a display control means which changes the display condition of a mark according to the number of times the specified element is specified. Hastings does teach a display control means which changes the display condition of a mark according to the number of times the specified element is specified in col. 10 lines 26-42. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Hastings and Huang into Huffman to have created the claimed invention.

It would have been obvious and desirable to incorporate a means for creating different versions of the same mark such as a varying underline thickness. This would have allowed the user to have more significantly marked the most important passages and less significantly marked passages of modest importance. This would have helped the user of the electronic book to have better organized the text contained in their electronic book.

**Regarding dependent claim 5,** Huffman does not teach changing the display condition of a mark according to the number of times the specified element is specified. Hastings does teach changing the display condition of a mark according to the number of times the specified element is specified in col. 10 lines 26-42. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Hastings and Huang into Huffman to have created the claimed invention.

It would have been obvious and desirable to incorporate a means for creating different versions of the same mark such as a varying underline thickness. This would have allowed the user to have more significantly marked the most important passages and less significantly marked passages of modest importance. This would have helped the user of the electronic book to have better organized the text contained in their electronic book.

***Response to Arguments***

6. Applicant's arguments, see pages 4-6, filed 11/10/2004, with respect to the rejection(s) of claim(s) 1, 3-4, and 6 under 35 U.S.C. 102(b) as being anticipated by Huffman et al., US 5,663,748 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art teaching single-step text selection and highlighting.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 571-272-4101. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS  
3/10/2005



JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER